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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/888,679	06/25/2001	Jeffrey R. Shutic	11694/04112	9972
27483	7590	12/27/2005	EXAMINER	
CALFEE, HALTER & GRISWOLD, LLP 800 SUPERIOR AVENUE SUITE 1400 CLEVELAND, OH 44114			NGUYEN, DINH Q	
			ART UNIT	PAPER NUMBER
			3752	

DATE MAILED: 12/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/888,679

Applicant(s)

SHUTIC ET AL.

Examiner

Dinh Q. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 October 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14, 28, 30-36, 38-43, 48-51 and 65 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-4, 8-12, 14, 28, 30-36, 38, 39, 42, 43, 48-51 and 65 is/are rejected.
- 7) ☐ Claim(s) 5-7, 13, 40 and 41 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 28, 31, 38, 42, 43, 48, 49 are rejected under 35 U.S.C. 102(b) as being anticipated by Lehmann et al.

Lehmann discloses a powder spraying system with a spray booth 10, a powder feed hopper, a spray hopper 19, a powder extraction device with a cyclone 48, a vacuum device 52/53 that conveys powder from powder outlet 51 through conduit 55 to the feed hopper (see figure 1), the conduit is fluid communicated impeller 52 that maintain negative pressure for the cyclone 58, thus conduit 55 in under negative pressure for drawing powder out of sieve 54 to the feed hopper (see column 5, lines 28-51).

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 3, 8-10, 14, 28, 31-33, 35, 36, 50, and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaneyfelt in view of Lehmann or Prinzing.

Shaneyfelt disclose a vacuum powder spraying system having a cylindrical spray booth 20 that is rotatable, a powder feed apparatus 136, a powder extraction apparatus that removes over sprayed powder to a first collector 44/46 that included a cyclone 114, a vacuum source 116 connected to the cyclone 114 to transfer powder overspray from a powder outlet at the bottom of the cyclone 114 to a second powder collection 124 under vacuum (see figure 1). Shaneyfelt does not disclose a conduit with negative pressure for transferring powder. Lehmann teaches a conduit 55 in under negative pressure for drawing powder. Prinzing teaches conveying conduit 61 under negative pressure (see column 4, lines 40-62) for transferring powder from cyclone 51 to a second powder collection device 62 (see figure 1). Therefore, it would have been obvious to one having ordinary skill in the art to have provided the device of Shaneyfelt with a negative pressure conduit as suggested by Lehmann or Prinzing. Doing so would provide a way for transferring powder between two locations.

5. Claims 2, 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaneyfelt in view of Lehmann or Prinzing as applied to claims 1, 3, 8-10, 14, 28, 31-33, 35, 36, 50, and 51 above, and further in view of Diaz.

Shaneyfelt in view of Lehmann or Prinzing teach all the limitations of the claims except for a dual cyclone separator. However, Diaz discloses a powder spraying system with spray gun 32, booth 14, feed hopper 56 of a feed center, and a dual cyclone separator 73 wherein the over spraying powder is being fed back to the feed hopper 56 (figure 1). Therefore, it would have been obvious to one having ordinary skill in the art to have provided the device of Shaneyfelt and Lehmann/Prinzing with a dual cyclone

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separator as suggested by Diaz. Doing so would provide an effective way to remove over spraying powder (column 2, lines 24-33).

6. Claims 11, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaneyfelt in view of Lehmann or Prinzing as applied to claims 1, 3, 8-10, 14, 28, 31-33, 35, 36, 50, and 51 above, and further in view of Fischli et al.

Shaneyfelt in view of Lehmann or Prinzing teach all the limitations of the claims except for a cyclone outlet interface. However, Fischli discloses a powder coating spray system comprising a spray booth 4, spray gun 8, a powder feed apparatus with powder supply lines 58, a powder extraction apparatus 34.1 and 34.2 to collect over spraying powder to a cyclone separator 46, a vacuum source 52, a second powder collection device 56, a vacuum duct 68/44 to remove powder overspray, a cyclone outlet interface with exhaust line 48 to vacuum source 52, over spraying powder collected by cyclone 46 and mix with fresh powder in the container 56, the powder in the container 56 is to be fed to spray gun 8. Therefore, it would have been obvious to one having ordinary skill in the art to have provided the device of Shaneyfelt and Lehmann/Prinzing with a cyclone outlet interface as suggested by Fischli. Doing so would provide an effective spraying device.

7. Claims 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaneyfelt in view of Lehmann or Prinzing as applied to claims 1, 3, 8-10, 14, 28, 31-33, 35, 36, 50, and 51 above, and further in view of Diaz.

Shaneyfelt teaches all the limitations of the claims except for a spray booth with floor comprises low conductive composite material. Diaz teaches a spraying system that

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is an electrostatic spraying system wherein surfaces, which are not to be painted, are to be grounds for deflecting the electrostatic charged paint powder from adhering to (column 5, lines 40-43). Therefore, at the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to configure the device of Shaneyfelt with low conductivity material such as composite material for preventing charged powder adhering to unwanted surfaces.

8. Claims 39, and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaneyfelt in view of Lehmann or Prinzing as applied to claims 1, 3, 8-10, 14, 28, 31-33, 35, 36, 50, and 51 above, and further in view of Ribnitz.

Shutic or Shaneyfelt teaches all the limitations of the claim except for the vacuum receiver being periodically interrupted. However, Ribnitz discloses a powder spraying system with a booth 2, a spray gun 3, with rotatable floor 5 (figure 1), and the vacuum receiver being periodically interrupted (column 6, lines 9-17). Therefore, it would have been obvious to one having ordinary skill in the art to configure the device of Shutic or Shaneyfelt with the vacuum receiver being periodically interrupted as suggested by Ribnitz. Doing so would provide an effective spraying system (column 2, lines 4-8).

### ***Double Patenting***

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir.

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1985); In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 1, 4, 28, 48, 50, and 65 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-27 of copending Application No. 10/476,602. Although the conflicting claims are not identical, they are not patentably distinct from each other because of common subject matter, as follows: a powder spray booth, a cyclone, a conduit with negative pressure that connecting the cyclone to a container, a vacuum source, a vacuum receiver and a filter, which are fully disclosed in claim 1, 4 and 5 of the '602 application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

#### **Allowable Subject Matter**

11. Claims 5-7, 13, 40, and 41 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

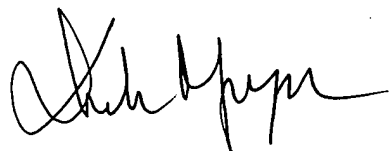
**Conclusion**

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. CH 529,590 to Prinzing is cited to show a powder coating spray system with a cyclone 16, a sieve 18, and a vacuum source 19.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dinh Q. Nguyen whose telephone number is 571-272-4907. The examiner can normally be reached on Monday-Thursday 6:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Scherbel can be reached on 571-272-4919. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Dinh Q Nguyen  
Primary Examiner  
Art Unit 3752